



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/689,721	08/12/96	PERRY	A

GREGORY T. KAVOUNAS
11654 S.W. PACIFIC HIGHWAY
SUITE 16B
TIGARD OR 97223

B2M1/0317

EXAMINER
LUEBKE, R

ART UNIT	PAPER NUMBER
2112	18

DATE MAILED: 03/17/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/689,721

Applicant(s)
Perry

Examiner
Renee S. Luebke

Group Art Unit
2112



☒ Responsive to communication(s) filed on Feb 6, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 5 is/are pending in the application.

Of the above, claim(s) none is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 5 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

1. The request filed on February 6, 1998 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/689721 is acceptable and a CPA has been established. An action on the CPA follows.
2. For applicant's information:
 - a. the most recent amendment, that filed February 6, 1998, has been designated as amendment "E" by the Office,
 - b. as per applicant's request, the amendments filed October 16, 1997 and November 7, 1997 have not been entered,
 - c. all previous claims have been cancelled, the only pending claim is claim 5 presented February 6, 1998, and
 - d. the drawing sheets submitted June 2, 1997 were not designated as formal and appeared to be informal proposals; as indicated in the Office action of September 18, 1997 (paper #8) the subject matter of these figures is acceptable and formal drawings will be required upon allowance of the application.
3. The substitute specification filed February 6, 1998 has not been entered because it does not conform to 37 CFR 1.121(a) or 1.125.

§1.121 Manner of making amendments.

(a) Erasures, additions, insertions, or alterations of the Office file of papers and records must not be physically entered by the applicant. Amendments to the application (excluding the claims) are made by filing a paper (which should conform to § 1.52) directing or requesting that specified amendments be made. The exact word or words to be stricken out or inserted by said amendment must be specified and the precise point indicated where the deletion or insertion is to be made.

§1.125 Substitute specification.

If the number or nature of the amendments shall render it difficult to consider the case, or to arrange the papers for printing or copying, the examiner may require the entire specification, including the claims, or any part thereof, to be rewritten. A substitute specification may not be accepted unless it has been required by the examiner or unless it is clear to the examiner that acceptance of a substitute specification would facilitate processing of the application. Any substitute specification filed must be accompanied by a statement that the substitute specification includes no new matter. Such statement must be a verified statement if made by a person not registered to practice before the Office.

The abstract as filed on August 6, 1996 and the substitute specification as filed on June 2, 1997 are presently of record and are considered below.

4. The substitute specification, filed June 2, 1997, remains objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

a. The requirement that the ring be "a few thousandths of an inch larger" than the recorder. This was not shown since the original drawings did not clearly show the relationship between the inside of the ring and the recorder. If anything, it appeared to show that they were essentially the same size. The measurement of "a few thousandths" certainly could not have been determined.

b. The use of a "thin cloth material" for the strap was not disclosed. Whether or not a particular material or structure "is a well known equivalent" is irrelevant to the issue of new matter.

c. The use of a "simple over-hand" knot was not originally disclosed. The original drawings were not sufficiently clear to discern the type of knot used and the specification was silent on this issue.

d. The suggestion that the principle may be "extended to applications involving other musical instruments or objects" was not originally presented.

Applicant is required to cancel the new matter in the response to this Office action.

5. Claim 5 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. In particular, the sizing limitation on the last line of the claim was not previously disclosed.

6. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The scope of the claims is indefinite because there is an inconsistency throughout the claim. The claim initially indicates that the subcombination, a supporting device, is being claimed. However, the claim also contains positive limitations directed toward the recorder, suggesting that applicant intends to claim the combination of the recorder and its supporting device. For this Office action only, the claimed device is considered to be the support. Applicant is required to clarify what subject matter the claim is intended to be drawn to and the language of the claim must be amended to be consistent with this intent.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 5 is rejected under 35 U.S.C. 102(b) as being anticipated by Wimmershoff-Caplan. This device comprises a ring 20 and a strap 30 suspended from the neck of a user. It may be sized to fit any intended item, including a recorder, for suspension.

9. **Any response to this action should be mailed to:**

Assistant Commissioner for Patents
Washington, DC 20231

or faxed to:

(703) 305-3432

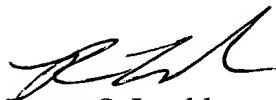
(informal or draft communications should be clearly labeled "PROPOSED" or "DRAFT")

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Hand-delivered responses should be brought to:
Crystal Plaza 4, Eleventh Floor (Receptionist)
2201 South Clark Place, Arlington, Virginia.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mrs. Renee Luebke at (703) 308-1511.



Renee S. Luebke
Primary Patent Examiner
March 15, 1998